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FEB 26 2008

REMARKS

This Application has been carefully reviewed in light of the Advisory Action Before the Filing of an Appeal on February 6, 2008 and the Final Office Action mailed November 28, 2007. At the time of this Final Office Action, Claims 1-21 were pending in this Application, of which all were rejected. The Applicant respectfully requests reconsideration and favorable action in this case.

A June 16, 2007 Office Action raised the following issues: (I) Claims 1-3, 5, 9, 11-13, 15 and 19 were rejected under 35 U.S.C. § 102(b); and (II) Claims 4, 6-8, 10, 14, 16-18, and 20-21 were rejected under 35 U. S. C. § 103(a).

The November 28, 2007 Final Office Action raised the same issues and noted that certain features that distinguished the present invention from the cited art were not specifically recited in the rejected claims. The accompanying amendment to the claims has now specifically recited the distinguishing features and placed this application in condition for allowance.

**I. Claims 1-3, 5, 9, 11-13, 15 and 19 Under 35 U.S.C. 102(b)**

The Office has rejected Claims 1-3, 5, 9, 11-13, 15 and 19 under 35 U.S.C. § 102(b) as being anticipated by Josse et al., U.S. Patent No. 6,104,929 ("Josse"). Claims 1-

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3, 5, 9, 11-13, 15 and 19 are patentable under 35 U.S.C. 102(b) over Josse because they recite methodology not present in the cited reference, and therefore distinguish over Josse. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection and allow pending Claims 1-3, 5, 9, 11-13, 15 and 19.

Claim 1 and Claim 11 distinguish over Josse because they claim exchanging messages between the RAN and the CN through a Hybrid Atrium-a feature that is not disclosed in Josse. This involves the RAN and the CN being of different technologies.

Applicant states:

The RAN 120 in turn communicates with a Serving General Packet Radio Service (GPRS) Serving Node (SGSN) 126. The SGSN 126 is a Hybrid SGSN that links the CDMA RAN to the GPRS Core Network. The SGSN 126 also includes a PL layer 122 and a R-P layer 124 as well as a L1 layer 127, a UDP/IP/L2 layer 130 and a GTP-U layer 132.

*See* patent application, p. 5. Applicant further states:

A typical wireless network is composed of two sub-networks: a Radio Access Network (RAN) which handles radio related issues such as assigning radio resources to a mobile terminal (or "mobile" in short) upon request for services, and a Core Network (CN) which links the mobile user to wireline networks. Current specification of wireless networks require that the RAN and CN have the same wireless technology in order to provide wireless services. These networks may be referred to as "homogeneous networks." For instance, a GSM mobile will only operate in a wireless network which its RAN and CN are both GSM wireless technology based. A hybrid network refers to a wireless network with its CN and RAN using different technologies. For example, the RAN may be based on CDMA2000 standard, while the CN may be based on GSM technology. Detailed description of a Hybrid Network can be found in co-pending PCT patent application serial no.

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PCT/US02/35500 which was filed on November 5, 2002 and entitled "Method and System for Providing Wireless Services in a Composite Wireless Network Comprising at Least One Access Network and One Core Network of Different Technologies.", assigned to the same assignee and is hereby incorporated by reference.

*See* patent application, p.4. However, Josse, describes communication on the very type of homogeneous network that applicant states is well-known in the art. Josse requires the same technology in the core network and radio access network and provides no disclosure showing how communication could occur in a wireless network utilizing a core network and a radio access network utilizing different technologies.

Josse states:

FIG. 1 shows an example cellular telecommunications network having GPRS capability for which the invention is useful. The network of FIG. 1 is shown using GSM-type terminology. While a preferred implementation is described in a GSM context/application, the present invention may be employed in other radio communications networks.

*See* Josse, column 4, lines 33-38. However, no matter what the radio communication network, the disclosure of Josse only involves a single homogeneous network and is inapplicable to a hybrid network using a core network and radio access network of different technologies.

Claims 2-3, 5 and 9 depend either directly or indirectly from Claim 1 and Claims 12-13, 15 and 19 depend either directly or indirectly from Claim 11. Therefore, these

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dependent claims are also not anticipated and are allowable for the same reasons set forth in the discussion of the Claim 1 and Claim 11 rejection.

Because the method disclosed in the Josse reference is not intended to or capable of providing the functionality provided by the claimed invention of the present application, Applicant respectfully requests that the Examiner withdraw this rejection.

**II. Claims 4, 6-8, 10, 14, 16-18, and 20-21 Rejected Under 35 U. S. C. § 103(a)**

The Office has rejected Claims 4, 6-7, 14, and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over Josse in view of 3GPP (ETSI TS 123 060 V3.3.0 (2000-04)), (“3GPP”). The Office has rejected Claims 8, 18 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Josse in view of Weissman, U.S. Patent Application No. 20030188319, (“Weissman”). The Office has rejected Claims 10 and 20 as being unpatentable over Josse in view of Weissman and further in view of Grilli et al., U.S. Patent Application No. 20030002525, (“Grilli”). However, all of these claims include methodology with new and advantageous steps and results, making such claims non-obvious over the cited references and thus patentable over Josse, 3GPP, Weissman and Grilli under 35 U.S.C. 103(a). Accordingly, Applicant respectfully requests the Examiner withdraw the rejection and allow pending Claims 4, 6-8, 10, 14, 16-18, and 20-21

Claims 4, 6-8 and 10 depend either directly or indirectly from Claim 1. Claims 14, 16-18 and 20 depend either directly or indirectly from Claim 11. As previously discussed,

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Claims 1 and 11 are allowable because they recite methodology not disclosed in Josse, meaning claims depending from Claim 1 and Claim 11 are also allowable.

Claim 21 contains the same limitation with regard to exchanging messages between the RAN and the CN through a Hybrid Atrium as Claim 1 and Claim 11 and is allowable for the same reasons discussed in conjunction with those claims.

Claims 4, 6, 7, 14, 16, and 17 rejections should also be withdrawn because they recite methodology not present in the cited reference Josse. In rejecting these claims, Examiner asserts that Josse discloses establishing a connection between the hybrid atrium and the MS and cites column 4, lines 45-51 of Josse for support. However, column 4, lines 50-52 of Josse make it clear that [t]he base station system (BSS) 30 communicates with various mobile radio stations, such as mobile station (MS) 40 shown in FIG. 1. Hence, it is the BSS that establishes a connection with the MS, not the hybrid atrium which Examiner asserts is Item 24 in FIG. 1 of Josse. Referencing FIG. 1 of Josse, it is apparent that this is in fact the case as no direct connection exists between the hybrid atrium 24 and the MS 40. Instead the MS 40 connects with the BSS 30 which connects with the hybrid atrium 24.

In contrast, applicant requires the MS to be capable of direct connection with the hybrid atrium.

The Hybrid Atrium 804 then sends a Create PDP Context Request message 832 with QoS, APN and PCO information to the GGSN 806. The GGSN 806 then sends a Create PDP Context Response 834 with Cause = "Request Accepted" to the Hybrid Atrium 804. The Hybrid Atrium 804 then sends an A11-Registration Reply (Lifetime, Accept) message 836 to the BSC/PCF 802. The BSC/PCF 802 then sends an Assignment Complete message 838 to the Hybrid Atrium

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804. A PPP connection 840 is then established between the Hybrid Atrium 804 and the MS 800 that allows User Data Transmission 842 between the two nodes 800 and 804.

*See* patent application, p. 7. The connection 840 is clearly between the hybrid atrium and the MS directly and not through some other component or system. FIG. 8 of the application also clearly shows the direct connection between the hybrid atrium and MS.

Even if, *arguendo*, all of the steps of claims 4, 6-8, 10, 14, 16-18 and 20-21 are present in the cited prior art, this does not necessarily render those claims obvious. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In *In Re Fine*, the claims were directed to a system for detecting and measuring minute quantities of nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however, the court found there was no support or explanation for this conclusion and reversed. *See id.*

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In this case, the prior art requires that the radio access network and core network have the same wireless technology (i.e. involve a homogeneous network) in order to provide wireless services. One of the key advantages of Applicant's invention is the ability to provide wireless service in a hybrid system. Here, there simply is no motivation or teaching found in the prior art to combine Josse (involving homogeneous networks) and 3GPP or Josse (involving homogeneous networks) and Weissman and/or Grilli. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682; MPEP 2143.01. No suggestion in Josse or any of the other cited references to combine the technologies therein has been cited or exists. "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); MPEP 2143.01.

Furthermore, secondary considerations of non-obviousness such as long felt but unsolved needs also must be considered in determining whether the combination of Josse,

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3GPP, Weissman and Grilli renders Applicant's invention obvious. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

The Josse patent was filed in 1998. The 3GPP reference is dated 2000-2004. The Weissman and Grilli patent applications were filed in 2003 and 2002, respectively. The problem Applicant has solved-providing wireless service in a hybrid network-has been present for many years despite the existence of these references. Despite a long felt need and demand for technology providing wireless service in a hybrid network, no device or method has ever been implemented to solve this problem over the time frame from 1998 to present. This is a strong indication that there is no motivation to combine the references due to the knowledge generally available to one of ordinary skill in the art.

Therefore, the Examiner should withdraw all rejections to Claims 4, 6-8, 10, 14, 16-18, and 20-21.

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CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims. If there are any matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to contact the undersigned attorney at 512-306-8533 at the Examiner's convenience.

Respectfully submitted,

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